REMARKS

Claims 36-59 are pending herein. Claims 37, 41, 45, 49, and 57 are cancelled, claims 36, 38-40, 42-44, 46-48, 50-56, and 58-59 are amended, and claims 60-61 are added herein.

Claims 36, 42, 43, 44, 50, 51, 52, 58, 59 and 60 are independent.

The Examiner's and Supervisory Examiner's participation in the interview on September 24, 2002, the discussions at which are summarized in the Interview Summary of the same date, is noted with appreciation.

Claims 40-41, 48-49 and 56-57 stand objected to under 37 C.F.R. §1.75(c) as being in improper dependent form. The objection is respectfully traversed.

The Examiner contends that, as originally presented, claims 40, 48 and 56 fail to further limit their parent claims 36, 44 and 52. However, claim 40, for example, requires that a determination be made as to whether or not the consumer's financial institute accepts electronic fund transfers. Parent claim 36, on the other hand, does not include such a determination. Accordingly, claim 40 further limits the invention recited in claim 36. Claims 48 and 56 further limit the inventions recited in their parent claims 44 and 52 for similar reasons.

Accordingly, it is respectfully requested that the objection be reconsidered and withdrawn.

Claims 36-42, 44-50 and 52-58 stand rejected under 35 U.S.C. §112 (first paragraph) as indefinite. Claims 36, 42, 44, 50, 52 and 58 are amended to delete unnecessary limitations which render the indefiniteness rejection moot.

Accordingly, it is respectfully requested that the rejection be reconsidered and withdrawn.

Claims 36-39, 43-47, 51-55 and 59 stand rejected under 35 U.S.C. §102(e) as anticipated by Tripp, Julie ("How to Lend Uncle Sam your money PAGE: B1"), the Oregonian; Portland, Oregon, October 28, 1990. Claims 42, 50 and 58 stand rejected under 35 U.S.C. §103(a) as obvious over Lawlor et al. (U.S. Patent No. 5,220,501), in further view of Tripp. Claims 37, 41, 45, 49 and 57 are cancelled without disclaimer or prejudice, and accordingly, the rejection is moot with respect to these claims. Claims 36, 44, and 52 are amended to further distinguish over routing number check digit verification. Other amendments are made solely for the purpose of deleting unnecessary limitations and/or clarification in view of amendment/cancellation of a parent claim. Thus, to the extent not addressed by the amendments to claims 36, 44 and 50, the rejections are respectfully traversed.

As discussed during the interview, Tripp lacks any teaching of a database of routing numbers associated with multiple financial institutions against which a routing number (for example, one received from a consumer) can be compared to verify the correctness or accuracy of the received routing number.

Tripp simply discloses that a user should confirm that its bank accepts electronic transfers of funds and lacks any disclosure whatsoever as to how such a confirmation should be performed.

The non-applied excerpts from "Routing Symbol and Transit Number", page 109, Chapter 6 - the Payment Function, by Francis et al., published by the

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American Bankers Association in 1994-1998, discloses, as acknowledged by the Examiner, a routine routing number verification performed using the self-check ninth digit of the routing number. Accordingly, this publication lacks any disclosure or suggestion of the comparison required by each of the independent claims 36, 42, 43, 44, 50, 51, 52, 58 and 59.

Furthermore, the Examiner acknowledges that Lawlor also lacks any suggestion of comparing a routing number to a database of financial institute routing numbers. Accordingly, Lawlor fails to cure the defects in the other relied upon references.

It is respectfully submitted that in rejecting claims under 35 U.S.C. §103(a), it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. In so doing, the Examiner is required to make the factual determination set forth in Graham v. John Deere Co. of Kansas City (148 USPQ 459 (1966)), and to provide a reason why one having ordinary skill in the art would have been led to modify the prior art or to combine the prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or inference in the prior art as a whole. It is imperative for the decision maker to place himself back in time to when the invention was unknown, i.e., without the Applicants' disclosure at his side, and determine, in light of all the objective evidence bearing on the issue of obviousness, whether one having ordinary skill in the art would have found the claimed invention as a whole obvious.

It should be recognized that the fact that the prior art could be modified so as to result in the combination defined by the claims would not have made the

modification obvious unless the prior art suggests the desirability of the modification

(See In re Deminski, 230 USPQ 313 (Fed. Circ. 1986)). In determining the issue of

obviousness, we must look to the collective teachings of the references relied upon

and to whether the hypothetical person of ordinary skill in the art, familiar with such

teachings would have found it obvious to make a corresponding structure or

process to that being claimed (See In re Fritch (23 USPQ 1780 (Fed. Circ. 1992)).

The test for combining references is not what the individual references

themselves suggest, but rather what the combination of disclosures taken at a

whole would suggest to one of ordinary skill in the art. In determining

obviousness, the inquiry is not whether each element existed in the prior art, but

whether the prior art made obvious the invention as a whole for which

patentability is claimed. Obviousness cannot be properly established by simply

showing that each claimed element may be found somewhere in the prior art

(See Hartness International, Inc. v Simplimatic Engineering Co. (2 USPQ 2d

1826 (Fed. Circ. 1987)). Without a suggestion of the invention in the prior art

reference combination, there is no motivation to combine the references.

Simplicity and hindsight are not proper criteria for resolving obviousness (In re

Warner, 154 USPQ 173 (CCPA 1967)). The mere possibility that the prior art

could be modified so as to result in the combination defined by the claims would

not have made the modification obvious unless the prior art suggests the

desirability of the modification. In the absence of such a suggestion the basis for

the rejection can only be viewed as nothing more than a hindsight reconstruction

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of the present invention using the Applicants' claims as a guide (See In re Deminski supra).

The issue is not whether it is within the skill of the art to make the proposed modifications, but rather if one skilled in the art, on consideration of the references, would have found it obvious to do so. It should be recognized that the fact that the prior art could be modified so as to result in the combination defined by the claims would not have made the modification obvious unless the prior art suggests the desirability of the modification (See In re Gordon 221 USPQ 1125 (Fed. Circ. 1984), and (In re Keller 208 USPQ 817 (CCPA 1981)).

It is respectfully submitted that the Examiner's conclusion of obviousness rejection is not based on what the prior art shows, teaches or suggests, but rather on the Examiner's view, that one of ordinary skill could have found the invention easy to conceive. Such a position is unsupported by any case law, and such simplicity and hindsight are not proper criteria for resolving obviousness (See In re Warner, supra). It is further respectfully submitted that there is nothing within any of the applied art teachings which would suggest the Examiner's proposed modification to arrive at the invention claimed in the present application. Rather, the applied prior art lacks any suggestion of the combination recited in each of the independent claims, including any suggestion such a combination of features could or would be beneficial. Further, it is respectfully submitted that the position taken by the Examiner is inconsistent with the explicit teachings within the art itself. In addition, it is unclear (and the Examiner has failed to provide any explanation of)

how skilled in the art one could go about combining the references as proposed to arrive at the subject invention.

As the Federal Circuit recently reiterated, if there is no suggestion or motivation to combine the references in the prior art itself, there is no basis for the combination. Reliance on common knowledge and/or common sense cannot be the basis of finding obviousness (See In re Lee 61 USPQ 2d 1430 (Fed. Circ. 2002)). The deficiencies in the applied art cannot be remedied by general conclusions which, in view of the disclosure in the present application, may appear to be common sensible.

With regard to the obviousness rejection based on Lawlor in view of Tripp, Lawlor discloses that all debiting of the user or customer's account is made via an ATM transfer. Accordingly, it is unclear why Lawlor would have any need to verify a routing number. The Examiner points to column 33, lines 28-37 as somehow implying "to include a routing number of the user's bank, as it is conventional to use a routing number in electronic funds transfer". The basis for the Examiner's assertion is unclear. The reference text does not even mention routing numbers and appears to provide no explicit or implicit disclosure relating thereto. Tripp also lacks any suggestion of the combination as proposed.

Accordingly, it is respectfully submitted that the proposed modification of Lawlor based upon the teachings of Tripp is unmotivated, and therefore, improper. However, even if the proposed combination were proper (which is not the case), it is respectfully submitted that the combined art would still lack various

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features of the claimed invention, including the required comparison and verification.

It is accordingly respectfully requested that the anticipation and obviousness rejections be reconsidered and withdrawn.

Other features further and independently distinguish the dependent claims over the applied prior art whether taken individually or in any combination.

For example, claim 39 requires that a received routing number be entered and that the comparison also verify that the number is entered correctly. The use of the conventional check digit would not allow such a verification since an improperly entered routing number could be verified against a check bit. Claim 40 requires that a determination be made as to whether or not the consumer's financial institute accepts electronic fund transfers and, if so, an instruction be generated to debit an amount of a bill from a consumer's deposit account by electronic fund transfer. As discussed above, Tripp lacks any teaching or suggestion relating to the debiting of a consumer's account, and Lawlor requires the debiting of the consumer's account by electronic fund transfer and hence has no need for determining whether or not such an account can accept electronic fund transfers based on a routing number (i.e. Lawlor requires the use of ATM). Accordingly, neither of the applied art, whether taken individually or in combination, teaches or suggests the explicit limitations of claim 40.

Other dependent claims are also independently distinguishable over the applied prior art for various reasons, including those discussed above.

Claims 60-61 are added to recite the invention in a somewhat different manner. It is respectfully submitted that these claims also distinguish over the applied prior art for reasons which should be clear from the above.

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance and an early indication of the same is courteously solicited. The Examiner is respectfully requested to contact the undersigned by telephone at the below listed local telephone number, in order to expedite resolution of any remaining issues and further to expedite passage of the application to issue, if any further comments, questions or suggestions arise in connection with the application.

Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 01-2135 and please credit any excess fees to such deposit account.

Respectfully Submitted,

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APPENDIX

AMENDMENTS TO CLAIMS

(DELETIONS IN BRACKETS AND ADDITIONS UNDERLINED)

36. (AMENDED) A method for processing consumer [supplied] banking information, comprising [the steps of]:

storing a plurality of routing numbers associated with a plurality of financial institutions in a financial institutions file;

receiving [from a consumer, via a network,] a routing number associated with a financial institution at which [the] a consumer maintains a deposit account; and

comparing the received routing number to the stored plurality of routing numbers in the financial institutions file to verify accuracy of [verifying that] the [consumer financial institution] received routing number [received from the consumer is correct].

38. (AMENDED) The method of claim [37] 36, further [including the step of] comprising:

rejecting the [consumer financial institution] received routing number [received from the consumer] if the accuracy is not verified because the [consumer financial institution] received routing number does not correspond to one of the stored plurality of routing numbers in the financial institutions file.

39. (AMENDED) The method of claim 36, further [including the steps of] comprising:

entering the [consumer financial institution] received routing number [into a computer system]; and

wherein the comparison also verifies [verifying] that the [consumer financial institution] received routing number is entered correctly.

40. (AMENDED) The method of claim 36, further [including the steps of] comprising:

receiving a request to pay a bill associated with a merchant on behalf of the consumer;

[processing the received request to determine] determining if the consumer financial institution [can process] accepts electronic fund transfers based on the verified routing number; and

[processing the received request to generate] generating an instruction to pay the bill by electronic fund transfer from the consumer deposit account if the consumer financial institution [can process] is determined to accept electronic fund transfers.

42. (AMENDED) A method for paying bills, comprising [the steps of]:

receiving[, via a network,] a request to pay a bill associated with a merchant on behalf of a consumer and a routing number associated with a financial institution at which the consumer maintains a deposit account;

comparing the [consumer financial institution routing number] received routing number to [a database of financial institution] routing numbers associated with a plurality of financial institutions in a financial institutions file to verify the accuracy of the received routing number;

[determine] determining if the consumer financial institution [can process] accepts electronic fund transfers based on the verified routing number; and

[processing the received request to generate] generating an instruction to pay the bill by electronic fund transfer from the consumer deposit account if the consumer financial institution [can process] is determined to accept electronic fund transfers.

43. (AMENDED) A method for determining if a financial institution can process electronic fund transfers, comprising [the steps of]:

[receiving from a plurality of financial institutions a plurality of financial institution routing numbers;]

storing [the] a plurality of [financial institution] routing numbers associated with a plurality of financial institutions in a financial institution database [containing financial institution information]; [and]

comparing a [financial institution] routing number associated with a financial institution to the plurality of routing numbers in the financial institution database [of financial institution information] to verify correctness of the routing number; and

[determine] determining if the financial institution [can process] accepts

electronic fund transfers based on the verified routing number.

44. (AMENDED) A system for processing consumer supplied banking

information, comprising:

[a network interface configured to receive from a consumer a routing

number associated with a financial institution at which the consumer maintains a

deposit account] a storage device configured to store a plurality of routing

numbers associated with a plurality of financial institutions; and

a processor configured to compare a routing number associated with a

financial institution at which a consumer maintains a deposit account to the

stored plurality of routing numbers, and thereby verify [that] correctness of the

consumer financial institution routing number [received from the consumer is

correct].

46. (AMENDED) The system of claim [45] 44, wherein the processor is further

configured to reject the consumer financial institution routing number [received

from the consumer] if the consumer financial institution routing number does not

correspond to one of the stored plurality of [financial institution] routing numbers

[stored in the storage device] and is therefore not verified.

47. (AMENDED) The system of claim 44, further comprising:

a data entry device for entering the consumer financial institution routing

number [received from the consumer];

wherein [the processor is further configured to verify that] the verification

also verifies correctness of the entry of the consumer financial institution routing

number [is entered correctly].

48. (AMENDED) The system of claim 44, [wherein] further comprising:

[the] a network interface [is further] configured to receive a request to pay

a bill associated with a merchant on behalf of the consumer; [and]

wherein the processor is further configured [to process the received

request] to determine if the consumer financial institution [can process] accepts

electronic fund transfers based on the verified consumer financial institution

routing number, and to generate an instruction to pay the bill by electronic fund

transfer from the consumer deposit account if the consumer financial institution

[can process] is determined to accept electronic fund transfers.

50. (AMENDED) A system for paying bills, comprising:

a network interface configured to receive a request to pay a bill associated

with a merchant on behalf of a consumer [and a routing number associated with

a financial institution at which the consumer maintains a deposit account];

a database of [financial institution] routing numbers associated with a

plurality of financial institutions; and

a processor configured (i) to compare [the consumer financial institution] a routing number associated with a financial institution at which the consumer maintains a deposit account to the database of [financial institution] routing numbers and thereby verify that the consumer financial institution routing number is correct, (ii) to determine if the consumer financial institution [can process] accepts electronic fund transfers based on the verified consumer financial institution routing number, and (iii) to generate an instruction to pay the bill by electronic fund transfer from the consumer deposit account if the consumer financial institution [can process] is determined to accept electronic fund transfers.

51. (AMENDED) A system for determining if a financial institution [can process] accepts electronic fund transfers, comprising:

a storage device configured to store a plurality of [financial institution] routing numbers [received from] associated with a plurality of financial institutions; and

a processor configured to [compare] verify accuracy of a [financial institution] routing number associated with a financial institution by comparing the routing number to the stored plurality of [financial institution] routing numbers [stored in the storage device] and to determine if the financial institution [can process] accepts electronic fund transfers based on the verified routing number.

52. (AMENDED) An article of manufacture for paying bills, comprising:

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a computer readable medium; and

computer programming stored on the medium;

wherein the stored computer programming is configured to be readable from the computer readable medium by a computer to thereby cause the computer to operate so as to:

[receive from a consumer, via a network,] <u>compare</u> a routing number associated with a financial institution at which [the] <u>a</u> consumer maintains a deposit account <u>to a plurality of routing numbers associated with a plurality of financial institutions</u>; and

verify that the consumer financial institution routing number [received from the consumer] is correct <u>based on the results of the comparison</u>.

53. (AMENDED) The article of manufacture according to claim 52, wherein the computer readable medium is further readable to cause the computer to:

[receive a store plurality of financial institution routing numbers from a plurality of financial institutions;]

store the plurality of [financial institution] routing numbers [received from the plurality of financial institutions] in a financial institutions file[; and

compare the consumer financial institution routing number received from the consumer to the financial institutions file to verify that the consumer financial institution routing number received from the consumer is correct].

54. (AMENDED) The article of manufacture according to claim [53] 52, wherein the computer readable medium is further readable to cause the compute to:

reject the consumer financial institution routing number [received from the consumer] if the consumer financial institution routing number [does] is determined not to correspond to any of the [financial institutions file] plurality of routing numbers based on the comparison.

55. (AMENDED) The article of manufacture according to claim 52, where the computer readable medium is further readable to cause the computer to:

receive the consumer financial institution routing number based on an input;

wherein the verification also verifies correctness of the input [verify that the consumer financial institution routing number is entered correctly].

56. (AMENDED) The article of manufacture according to claim 52, wherein the computer readable medium is further readable to cause the computer to:

receive a request to pay a bill associated with a merchant on behalf of the consumer;

[process the received request to] determine if the consumer financial institution [can process] accepts electronic fund transfers based on the verified consumer financial institution routing number; and

[process the received request to] generate an instruction to pay the bill by electronic fund transfer from the consumer deposit account if the consumer

financial institution [can process] is determined to accept electronic fund transfers.

58. (AMENDED) An article of manufacture for paying bills, comprising:

a computer readable medium; and

computer programming stored on the medium;

wherein the stored computer programming is configured to be readable from the computer readable medium by a computer to thereby cause the computer to operate so as to:

receive, via a network, a request to pay a bill associated with a merchant on behalf of a consumer [and a routing number associated with a financial institution at which the consumer maintains a deposit account];

compare [the consumer financial institution] a routing number associated with a financial institution at which the consumer maintains a deposit account to a database of [financial institution] routing numbers associated with a plurality of financial institutions to verify accuracy of the consumer financial institution routing number;

determine if the consumer financial institution [can process] accepts electronic fund transfers based on the verified consumer financial institution routing number; and

[process the received request to] generate an instruction to pay the bill by electronic fund transfer from the consumer deposit account if the consumer

financial institution [can process] is determined to accept electronic fund transfers.

59. (AMENDED) An article of manufacture for determining if a financial institution can process electronic fund transfers, comprising:

a computer readable medium; and

computer programming stored on the medium;

wherein the stored computer programming is configured to be readable from the computer readable medium by a computer to thereby cause the computer to operate so as to:

[receive from a plurality of financial institutions a plurality of financial institution routing numbers;]

store [the] a plurality of [financial institution] routing numbers associated with a plurality of financial institutions in a database [containing financial institution information]; [and]

compare a [financial institution] routing number associated with a financial institution to the plurality of routing numbers in the database [of financial institution information to];

verify the accuracy of the routing number based on the comparison; and

determine if the financial institution [can process] accepts electronic fund transfers based on the verified routing number.